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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,943	09/29/2000	Angelika Esswein	9486	8960

151 7590 02/05/2002  
HOFFMANN-LA ROCHE INC.  
PATENT LAW DEPARTMENT  
340 KINGSLAND STREET  
NUTLEY, NJ 07110

EXAMINER	
STOCKTON, LAURA LYNNE	
ART UNIT	PAPER NUMBER
1626	12

DATE MAILED: 02/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.  
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### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on January 25, 2002
- ☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~whichever~~ whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 7 and 21-24 ☐ are pending in the application.
- ☐ Of the above, claim(s) 21 and 22 ☐ are withdrawn from consideration.
- ☐ Claim(s) 7, 23 and 24 ☐ is/are allowed.
- ☒ Claim(s) 7, 23 and 24 ☐ are rejected.
- ☐ Claim(s) 7, 23 and 24 ☐ is/are objected to.
- ☐ Claim(s) 7, 23 and 24 ☐ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

09/675,943

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## DETAILED ACTION

Claims 7 and 21-24 are pending in the application.

### *Election/Restrictions*

Applicants' election with traverse of Group II in Paper No. 9 was acknowledged in the previous Office Action. The requirement was still deemed proper and was therefore made FINAL in the previous Office Action.

Claims 21 and 22 and subject matter not embraced by elected Group II is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

### *Specification*

The abstract has been found in the application.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “, and salts, esters, optically active forms and racemates which can be metabolized *in vivo* to yield the corresponding compound of formula (I)” in claim 7 should be deleted since the phrase “and derivatives of said compounds” has been deleted from the claim.

*Allowable Subject Matter*

The elected invention of Group II is free of the art of record.

*Response to Arguments*

Applicants' arguments filed January 25, 2002 have been fully considered. Applicants argue that the Patent Office is obligated to examine on the merits all claims that have not been withdrawn from consideration because of the restriction requirement.

Applicants' arguments have been considered but have not been found persuasive for reasons of record in Paper No. 10, pages 2-4. It is noted that Applicants did not make the argument that the products of Group I are **not independent and** patentably distinct from the products of Group II. Therefore, the requirement is deemed proper.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

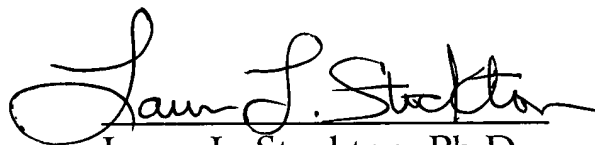
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

This application contains claims 21 and 22 and subject matter which is drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims and subject matter (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235, 308-0196 or 305-3290.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556, 308-4242, 305-1935 or 308-2742.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

February 5, 2002